

REMARKS/ARGUMENTS

Claims 1-5, 11, and 14-18 are active in this application.

The claims have been amended to define the soybean as lacking all subunits of β -conglycinin and glycinin (claim 1 or does not express the subunits--claim 14), which is supported by the disclosure of the soybean lines QF2F₃-1, QF2F₃-2, and QF2F₃-3 (see, e.g., the specification on page 11, lines 23-24: "Specifically, lines (QF2F₃-1, QF2F₃-2 and QF2F₃-3) wherein deficiency in all subunits of β -conglycinin and glycinin had been genetically fixed were selected.")

No new matter is added.

As claimed herein, the invention is directed to soybean (and their seeds) that fail to express certain subunits of β -conglycinin and glycinin, the result of which is a soybean line (and their seeds) that have a total free amino acid content greater than that found in seeds of conventional soybean varieties or lines. This is particularly advantageous in terms of the use of the soybean (and their seeds) in preparing functional foods high in free amino acids, the advantages of which are discussed, e.g., on pages 1-2 of the specification.

The rejections under 35 USC 112, first paragraph (written description and enablement) are respectfully traversed.

The Advisory Action of June 28, 2007 indicates that Office maintains that the claims do not meet the requirements for written description and enablement because Applicants have only shown possession of specific soybean lines and not each and every soybean plant with the claimed characteristics (see page 2 of the Action).

The claims require that the soybean lack all subunits of β -conglycinin and glycinin (claim 1 or does not express the subunits--Claim 14). As discussed in the paragraph bridging pages 1-2 of the specification the five units and expression mechanism are known. The fact that these subunits were known, the specification and claims satisfy the written description

requirement because once one knows the structure, one can generate a soybean lacking or not expressing those known sequences. (see *Capon v. Eshhar* (Fed. Cir. 2005): “When the prior art includes the nucleotide information, precedent does not set a *per se* rule that the information must be determined afresh.”; see also *Falkner v. Inglis*, 79 USPQ2d 1001 (Fed. Cir. 2006): “Recitation of Known Structure Is Not Required” to satisfy written description requirement).

Thus, if the soybean lacking or not expressing the subunits is described then it can be practiced without undue experimentation. In particular, once one has the structure of the subunits in hand, it is routine in the field to make mutants so that the subunits do not express, e.g., as in Claim 14.

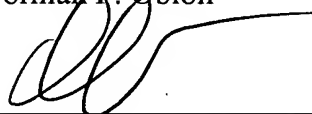
The function or phenotype of the soybean results from the mutation of those subunits as exemplified by the the disclosure of the soybean lines QF2F₃-1, QF2F₃-2, and QF2F₃-3.

Accordingly, reconsideration and withdrawal of the rejections is requested.

A Notice of Allowance indicating that the pending claims are allowed is also requested.

Respectfully submitted,

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